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In re Application of :
TULLY et al :
Serial No.: 09/523,066 : Decision on Petition
Filing Date: 10 March 2000 :
Attorney Docket No. 1314.1058-001 :

This Petition under 37 CFR 1.144 was filed on 1 February 2002. It was only recently brought to the attention of the deciding official. The delay in acting upon this petition is regretted.

BACKGROUND

A review of the file history shows that the Office mailed a two-way Restriction Requirement which was subsequently made final.

The groupings are reproduced below:

Restriction to one of the following inventions is required under 35 U.S.C. 121.

Group I Claims 1- 10 and 16-23, drawn to a method of identifying a gene or genes in non-human animals, classified in class 424, subclass 9. 1.

Group II. Claims 11- 15 and 24-26, drawn to a method of identifying a gene or genes in *Drosophila*, classified in class 424, subclass 9. 1.

The Examiner supported this restriction because she reasoned that the search was divergent and the inventions were distinct. Group II was elected with traverse.

Relevant portions of the independent claims are reproduced below:

For Group I:

Claim 1. A method of identifying a gene or genes involved in transcription-dependent memory comprising the steps of:

- (a) training non-human animals under conditions sufficient to induce transcription-dependent memory formation in said animals,
- (b) extracting RNA from brain tissue of said animals trained in step (a)...

For Group II:

- Claim 11. A method of identifying a gene or genes involved in transcription-dependent memory comprising the steps of:
- (a) training *Drosophila* to induce transcription-dependent memory formation in said *Drosophila*;
 - (b) extracting RNA from head tissue of *Drosophila* trained in step (a)...

This Petition was filed 1 February 2002.

Subsequent to the filing of the petition, Applicants filed a Notice of Appeal on 15 October 2002, an Appeal Brief and Oath or Declaration on 23 April 2003 and an affidavit or declaration and Appeal Brief on 17 October 2003.

The Office found the first Appeal Brief defective under 37 CFR 1.192(c) for a problem with the required Summary of Invention.

The second Appeal Brief was found defective in view of the affidavit or declaration, which was considered untimely under 37 CFR 1.195.

DISCUSSION

The application, file history and petition have been considered carefully.

The petitioner points to Paper No. 7, page 2, lines 8-10 in which the Examiner states:

the method of Invention I operates by training non-human animals and extracting brain-specific RNA for analysis and function to identify non-human gene or genes and the method of Invention II operates by training *Drosophila* and extracting head tissue-specific RNA for analysis and functions to identify a *Drosophila* gene or genes. Paper No. 7, at page 2, lines 12-16.

The Petitioner points to MPEP 803.02 which states in part,

If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to distinct or independent inventions (emphasis added by petitioner).

This position is persuasive. The Examiner has not established that concurrent examination of both Groups I and II would require a burdensome search. Both Group I and Group I are classified in Class 424, subclass 9.1. Both Groups I and II overlap in scope. The *Drosophila* of Group II is a subset of the non-human animals of Group I and a search of Group II is not

divergent from that of Group I. A search for the brain tissue of animals corresponds to and overlaps with a search for the head tissue from *Drosophila*. Further, as rejection of Group II would apply to Group I. For these reasons, the restriction requirement between Group I and II is in error and is withdrawn.

DECISION

The petition is **GRANTED** for the reasons set forth above.

The final Office action mailed 10 April 2002 withdrawn in view of the restriction requirement being withdrawn. An action on the merits of all claims will follow.

In addition, Notification of Non-Compliance under 37 CFR 1.192(c), which improperly found the Appeal Brief defective under 37 CFR 1.195 because of the timeliness of the affidavit mailed 23 October 2003 has been vacated. Timeliness of an affidavit, declaration or exhibit under 37 CFR 1.195 is not a valid reason to find an Appeal Brief non-compliant under 37 CFR 1.192(c).

Applicant may file a request for a refund of the Notice of Appeal fee.

Should there be any questions with regard to this letter, please contact Special Program Examiner Julie Burke by letter addressed to the Director, Technology Center 1600, PO Box 1450, Alexandria VA 22313-1450 or by telephone at (571) 272-1600.


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